

REMARKS

Reconsideration and withdrawal of the rejections of this application and consideration and entry of this paper are respectfully requested in view of the herein remarks, which place the application in condition for allowance.

I. NOTICE REGARDING U.S. SN: 09/856,188 and U.S. Patent 6,746,987

The applicants' wish to remind the Examiner that he is also the examiner of record for U.S. Application Serial No. 09/856,188. Both applications are currently owned by Bayer CropScience AG.

A communication was sent by the Examiner in the '188 application indicating that claims 34 and 35 of that application corresponded to claims 7 and 10 respectively of Rüegg (U.S. Patent 6,489,267) for the purposes of establishing a count for an interference. The Rüegg reference served as the basis of an objection to claims 23-41, 59, 60, 62, 63, 65, 66, 68, 69 and 71-92 in the present application under 35 U.S.C. §135(a).

The applicants also bring the Examiner's attention to a second patent issued to Rüegg (U.S. Patent 6,746,987) which is cited as part of the accompanying IDS.

II. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 1, 4, 5, 16, 18, 19 and 21-40 are pending in this application. Claim 17 has been cancelled, claim 29 has been amended, and claims 39 and 40 have been added. Applicants reserve the right to pursue the subject matter of cancelled claims in continuing applications. No new matter has been added by this amendment.

The Examiner indicated that the elected species had been expanded to encompass applicant's isoxazolyl herbicides (A is A-1 or A-2) and diketonitrile herbicides (A is A-3) and that no claims remain withdrawn from examination.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112. The amendments of the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

III. THE CLAIM OBJECTIONS ARE OVERCOME

Claims 61, 64, 67 and 70 have been amended to address the Examiner's objections with regard to improper multiple dependency and this rejection may be withdrawn.

Claims 63, 65, 68, 69 and 71 were rejected as being substantial duplicates of earlier claims (claims 63 with 60; claims 65, 68 and 71 with 62; and claim 69 with 39). Claim 63 has been amended to delete reference to Q2 and is no longer a duplicate of claim 60. The dependencies for claims 65, 68 and 71 have been corrected so that it is no longer a substantial duplicate of claim 62. However, for claim 69, while the herbicide and the safener is the same as that of claim 39, the remaining scope of the claims are not identical. Therefore, claim 69 is not a substantial duplicate of claim 39.

III. THE 35 U.S.C. 112, 2nd PARAGRAPH REJECTIONS HAVE BEEN OVERCOME

The typographical errors with respect to claims 59 and 62 have been corrected and this rejection may be withdrawn.

IV. THE 35 U.S.C. 102 and 103 REJECTIONS HAVE BEEN OVERCOME

Claim 58 was rejected as allegedly being anticipated by Penner et al. (U.S. Patent 6,235,682) and as allegedly being obvious over the combination of Penner et al., *ibid.* and Forget et al. (U.S. Patent 5,905,057). While the applicants do not agree with the Examiner's rejection, this rejection has been rendered moot by the cancellation of claim 58. The applicants reserve the right to continue prosecution of this claim in a continuing application.

V. THE OBJECTION OVER RÜEGG (U.S. PATENT 6,489,267)

Applicants are entitled to status as senior party if an interference is declared

The applicants note that the certified copies of the priority document for this application (GB 9921220-1 and GB 0012090-7) were received in this application. The earliest filed application, GB 9921220-1, was filed on **September 8, 1999**, and was published in the English language, i.e. the claim for foreign priority has been perfected.

The earliest claim for priority of record in the Rüegg patent is to CH 1700/99 which was filed on **September 16, 1999**.

Therefore, based on the evidence of record at this time, the applicants should be accorded status as the senior party should an interference be declared.

Standard for determining whether an interference exists

37 CFR §41.203(a) Interfering subject matter states: “An interference exists if the subject matter of a claim of one party would, if prior art, have anticipated or rendered obvious the subject matter of a claim of the opposing party and vice versa.”

This “two-way” test was first elucidated by the Board in *Winter v. Fujita*, 53 USPQ2d 1234 (BPAI 1999) and approved by the Federal Circuit in *Eli Lilly & Co. v. Board of Regents of the University of Washington*, 334 F.3d 1264, 67 USPQ2d 1161 (Fed. Cir. 2003).

However, for the purposes of determining whether “...subject matter of a claim of one party would, if prior art, have anticipated or rendered obvious the subject matter of a claim of the opposing party and vice versa.”, it is noted that **genus and species claims define ‘separate patentable inventions’ if the species is separately patentable from the genus.** *Eli Lilly & Co.*, 334 F.3d at 1270 (emphasis added), see also USPTO’s Notice of Final Rule, *Patent Interference Proceedings*, 49 Fed. Reg. 48,416, 48,433 (Dec. 12, 1984).

As the file history of Rüegg (U.S. Patent 6,489,267) reveals that Rüegg indeed argued that their invention was a species over a genus, Rüegg has essentially conceded that any genus claim is a separate patentable invention and therefore should not be subject to interference.

Should the Examiner declare an interference, the applicants request that the Examiner identify those claims which constitute “genus” claims and would not be subject to interference proceedings.

REQUEST FOR INTERVIEW

In the interest of adhering to the tenets of compact prosecution and obtaining good customer service (see page 7 of the FY-2004 Performance and Accountability Report), the applicants request that the teachings of MPEP 707.07(j), sections II and III be applied, especially with regard to the offer of suggestion for correction by the Examiner if the rejections are upheld.

In accordance with MPEP 713.01, section III, should any issue remain as an impediment to allowance, an interview with the Examiner and SPE are respectfully requested; and, the Examiner is additionally requested to contact the undersigned to arrange a mutually convenient time and manner for such an interview (“An interview should normally be arranged for in advance, as by letter, facsimile, electronic mail, telegram or telephone call, in order to insure that

the primary examiner and/or the examiner in charge of the application will be present in the office.” *Id.*).

CONCLUSION

In view of the remarks and amendments herewith, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution. The Commission is authorized to charge any fee occasioned by this paper, or credit any overpayment of such fees, to Deposit Account No. 50-0320.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP
Attorneys for Applicants

By: Howard C. Lee

Howard C. Lee
Reg. No. 48,104
(212) 588-0800